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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,937	01/24/2000	Koji Nakagiri	862.C1801	6485

5514 7590 09/29/2003

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NEW YORK, NY 10112

EXAMINER
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BASHORE, WILLIAM L

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 09/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/489,937	NAKAGIRI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	William L. Bashore	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 13 April 2000.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-37 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-37 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

1. This action is responsive to communications: original application filed 1/24/2000, with priority filing date of 1/28/1999.
2. Claims 1-37 are pending. Claims 1, 8, 15, 22, 29, 30, 31, 36, 37 are independent claims.

*Specification*

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: "System, Method, And Apparatus For Changing Output Size Of An Electronically Transmitted Document".

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid et al. (hereinafter Schmid), U.S. Patent No. 5,659,164 issued August 1997, in view of Ogura (hereinafter Ogura), U.S. Patent No. 5,019,916 issued May 1991.**

**In regard to independent claim 1,** Schmid teaches an electronic facsimile method comprising scanning a document, and electronically transmitting said document along with page specific information, said document and page information temporarily (inherently) stored in memory in an intermediate format (i.e. digital data stored in RAM memory) prior to, and during transmission of information (Schmid Abstract, column 2 lines 4-23, 27-33, 40-45, 57-61, column 4 lines 57-67; compare with claim 1 “*An information processing system....said system comprising:*”, and “*temporary storing means for temporarily storing, on a storage medium in an intermediate data format, output image data composed of a plurality of pages as well as output configuring information;*”).

Schmid teaches storing page size information on a cover page of a document, said information used for ascertaining final page size (Schmid column 4 lines 57-67, Figure 4; compare with claim 1 “*acquisition means for acquiring output size of a prescribed page ....by said temporary storing means;*”).

Schmid does not specifically teach changing the size of each page based upon the output size. However, Ogura teaches electronic facsimile transmission whereby a transmitting station is notified of a receiving station’s paper size. If said receiving station’s paper size differs from the fax size, then the receiving station enlarges/reduces the fax size accordingly prior to transmission, so as to fit the receiving station’s paper size (Ogura Abstract, column 10 lines 65-68 to column 11 lines 1-30; compare with claim 1 “*changing means for changing the size of each page of the output image data based upon the output size acquired by said acquisition means.*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Ogura to Schmid, providing Schmid the benefit of destination page size information, in order to change page size (originally declared by Schmid’s cover sheet data) to fit a variety of paper sizes within various facsimile machine brands.

**In regard to dependent claim 2,** Schmid teaches page size information embedded on a cover page (a leading page of a fax document (Schmid column 4 lines 57-67).

In regard to dependent claim 3, Schmid does not specifically teach changing the size of each page based upon the output size as specified by the cover sheet data. However, Ogura teaches electronic facsimile transmission whereby a transmitting station is notified of a receiving station's paper size. If said receiving station's paper size differs from the fax size, then the receiving station enlarges/reduces the fax size accordingly prior to transmission, so as to fit the receiving station's paper size (Ogura Abstract, column 10 lines 65-68 to column 11 lines 1-30, Figure 1, 4) It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Ogura to Schmid, providing Schmid the benefit of destination page size information, in order to temporarily modify Schmid's cover sheet page size content information, so as to fit a variety of paper sizes within various facsimile machine brands.

In regard to dependent claim 4, Schmid does not specifically teach changing the size of each page based upon the output size as specified by the cover sheet data, so as to be identical with ouput paper size. However, Ogura teaches electronic facsimile transmission whereby a transmitting station is notified of a receiving station's paper size. If said receiving station's paper size differs from the fax size, then the receiving station enlarges/reduces the fax size accordingly prior to transmission, so as to fit the receiving station's paper size (Ogura Abstract, column 10 lines 65-68 to column 11 lines 1-30, Figure 1, 4) It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Ogura to Schmid, providing Schmid the benefit of destination page size information, in order to temporarily modify Schmid's cover sheet page size content information, so as to fit a variety of paper sizes within various facsimile machine brands.

In regard to dependent claims 5, 6, as presented in the rejection of claim 1, above, Schmid (in view of Ogura) teaches enlarging/reducing output page sizes, based upon analysis of Schmid's cover sheet information and Ogura's applied teaching of transmitted paper size information. Since a cover sheet is typically part of a transmitted fax document, and since page size modifications apply to a faxed document, said cover sheet is also changed accordingly (see also Schmid column 4 lines 57-67) (compare with claims 5, 6).

**In regard to dependent claim 7,** Schmid teaches a fax transmission (Schmid column 2 lines 27-34, especially lines 40-44).

**In regard to claims 8-14,** claims 8-14 reflect the apparatus comprising computer executable instructions used for implementing the system as claimed in claims 1-7, respectively, and are rejected along the same rationale.

**In regard to claims 15-21,** claims 15-21 reflect the computer executable methods comprising computer executable instructions used for implementing the system as claimed in claims 1-7, respectively, and are rejected along the same rationale.

**In regard to claims 22-28,** claims 22-28 reflect the computer executable methods comprising computer executable instructions used for implementing the system as claimed in claims 1-7, respectively, and are rejected along the same rationale.

**In regard to independent claim 29,** claim 29 reflects the computer program product comprising computer executable instructions used for implementing the system as claimed in claim 1, and is rejected along the same rationale.

**In regard to independent claim 30,** claim 30 reflects the computer program product comprising computer executable instructions used for implementing the system as claimed in claim 1, and is rejected along the same rationale.

**In regard to independent claim 31,** claim 31 reflects the apparatus comprising computer executable instructions used for implementing the system as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Schmid teaches page size information embedded on a cover page (a leading page of a fax document (Schmid column 4 lines 57-67; compare with claim 31 “*to attach cover page information*”).

**In regard to dependent claim 32,** claim 32 reflects the apparatus comprising computer executable instructions used for implementing the system as claimed in claim 7, and is rejected along the same rationale (see also Schmid Figure 1, 2A – scanned and OCR’d images of page documents).

**In regard to dependent claim 33,** claim 33 reflects the apparatus comprising computer executable instructions used for implementing the system as claimed in claim 2, and is rejected along the same rationale.

**In regard to dependent claims 34, 35,** Schmid does not specifically disclose template information associated with cover page information, as claimed. However, Schmid teaches an “MRI” comprising a set display of page information, which provides the claimed equivalent of an information template, the size of said cover page (with attached MRI) to be adjusted (scaled) as needed (Schmid Figure 1, 4), providing Schmid the benefit of a standard presentation of information for defining fax documents.

**In regard to independent claim 36,** claim 36 reflects the computer executable method comprising computer executable instructions used for implementing the system as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Schmid teaches page size information embedded on a cover page (a leading page of a fax document (Schmid column 4 lines 57-67; compare with claim 36 “*generating cover page information*”).

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**In regard to independent claim 37, claim 37 reflects the computer program product comprising computer executable instructions used for implementing the system as claimed in claim 1, and in further view of the following, is rejected along the same rationale.**

Schmid teaches page size information embedded on a cover page (a leading page of a fax document (Schmid column 4 lines 57-67; compare with claim 37 “*generating cover page information*”).

### *Conclusion*

**6. Prior art made of record and not relied upon is considered pertinent to disclosure.**

Semasa	U.S. Patent No. 5,418,626	issued	05-1995
Toyoda et al.	U.S. Patent No. 6,493,103	issued	12-2002
Kocher	U.S. Patent No. 6,188,766	issued	02-2001
Watts et al.	U.S. Patent No. 6,559,971	issued	05-2003
Bobo, II	U.S. Patent No. 6,564,321	issued	05-2003
Menezes et al.	U.S. Patent No. 5,621,894	issued	04-1997
Fite, Jr et al.	U.S. Patent No. 5,517,324	issued	05-1996
Meguro et al.	U.S. Patent No. 5,339,169	issued	08-1994

Kimura, Youichi, Digital Copying Machine, European Patent Application, Publication No. 0 578 184 A1, published January 12, 1994.

Gittlen, Sandra, Software takes a bite out of fax costs, Network World, June 2, 1997, Volume 14, Issue 22, page 43.

Bar Code Photocopier and Applications, IBM Technical Disclosure Bulletin, December 1, 1989, Volume 32, Issue 7, pages 305-307.

**7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bashore whose telephone number is (703) 308-5807. The examiner can normally be reached on Monday through Friday from 11:30 AM to 8:00 PM EST.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild, can be reached on (703) 305-9792.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 305-3900**.

**8. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**(703) 746-7239** (for formal communications intended for entry)

**or:**

**(703) 746-7240** (for informal or draft communications, please label  
“PROPOSED” or “DRAFT”)

**or:**

**(703) 746-7238** (for after-final communications)

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA, Fourth Floor (Receptionist).**

William L. Bashore  
September 20, 2003



SANJIV SHAH  
PRIMARY EXAMINER